

Application Ser. No.: 10/613,588
 Filing Date: July 3, 2003
 Examiner: Huang, Evelyn Mei

Remarks

In the Office Action, the Examiner noted that claims 1 to 24 are pending in the application; claims 5-10 and 14-24 are withdrawn from consideration; claims 1, 2, 4, 11 and 12 are rejected; and that claims 3 and 13 are objected to. By this amendment, claims 1, 4, 11 and 14 have been amended. Thus, claims 1 to 24 are pending in the application. No new subject matter has been inserted through these amendments. All of the amendments are fully supported by the specification and further discussed in detail below. The Examiner's rejections are traversed below.

Election/Restrictions

In particular, the Examiner has given a four-way restriction pursuant to 35 USC 121 as follows:

<i>Inventions</i>	<i>Classification</i>
Group I. Claims 1-4 and 11-13 drawn to a compound of formula (I) and the composition thereof.	Not provided
Group II. Claims 6-10 drawn to multiple methods of use with the compound of formula (I).	Not provided
Group III. Claims 14-24 drawn to multiple method of use with a compound of formula (I).	Not provided
Group IV. Claim 5 drawn to a composition comprising multiple active ingredients.	Not provided

In a telephonic conference with the Examiner on February 22, 2005, the undersigned had elected provisionally invention Group I *with traverse*, namely, claims 1-4 and 11-13, drawn to a compound of formula (I). Applicants confirm by way of this response election of invention Group I with traverse.

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However, Applicants respectfully submit that this four-way restriction as imposed by the Examiner is improper based on the following grounds:

1. There is no undue burden on the Examiner to search for all of the claims as they are believed to be in the same and/or similar classification.
2. Product, process of making them and their uses should be rejoined pursuant to MPEP 821.04
3. Imposes undue expense and discourages Applicants to maintain a plurality of patents, which is against the constitutional intent to promote the progress of science and technology and thus against the public policy.

Now, we address each one of these issues in greater detail. First, Applicants respectfully submit that the search of all of the claims 1 to 24 should not impose any undue burden on the Examiner. In support of our assertion, we draw Examiner's attention to the Table shown above, which lists four groupings of the invention. Although the Examiner has not provided any search classifications for these four invention groups, it is believed that all of these four groups are either in the same search group or in a similar search sub-group. Therefore, it is respectfully submitted that search of all groups together should not impose any undue burden on the Examiner. Even more importantly, when the Examiner is searching in one class, that itself may facilitate the search of the other invention groups. Thus, it does not impose any undue burden on the Examiner to search all of the inventions together. Therefore, Applicants respectfully submit that all of the inventions be rejoined and examined together.

Secondly, Applicants submit that product and the related process claims should be rejoined pursuant to MPEP 821.04. As noted in MPEP 821.04:

"However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined."

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Where the application as originally filed discloses the product and the *process for making and/or using the product*, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the *process of making and/or using the patentable product* by way of amendment pursuant to 37 CFR 1.121. (emphasis added)

As noted above, invention group I, claims 1-4 and 11-13, is directed to various compounds and compositions of the invention. More particularly, the Examiner has already indicated that claims 3 and 13 directed to certain specific compounds and compositions of the invention are in condition for allowance. As further discussed below, claims 1, 2, 4, 11, and 12, as amended, are also in condition for allowance. Invention groups II and III, claims 6-10, and 14-24, recite methods of use of the compound of formula (I) and certain specific compounds, all of which are of the same scope as that of compound claims 1-4 and 11-13. In fact, dependent claim 6 depends directly upon claim 1 including all of the limitations of claim 1 and further recite method of use of compound of formula (I). Dependent claims 7-10 depend directly upon claim 6 and further recite additional limitations. Independent claim 14 recites a method of use of the compound of formula (I) having the same scope as that recited in claim 1, and dependent claims 15-24 depend directly or indirectly upon claim 14 and further recite additional limitations. Similarly, invention group IV, claim 5, directly depends on claim 1 incorporating all of the limitations of claim 1 and further recites a composition. Thus, all of the invention groups II to IV should be rejoined with invention group I pursuant to MPEP 821.04.

Finally, Applicants respectfully submit that this four-way restriction imposes an undue expense on the Applicants and discourages Applicants to maintain a plurality of patents, which is against the constitutional intent to promote the progress of science and technology and thus against the public policy. For these reasons and for the reasons advanced above, Applicants request the Examiner to reconsider and withdraw this restriction requirement.

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Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 2, 5, 11 and 12 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, the Examiner alleges that independent claims 1 and 11 recite 'heteroaryl having from 5-14 ring members' and 'heterocycle having from 5-12 ring members,' both of which are unclear in the absence of the recitation of the type and number of rings, the type and number of the heteroatoms in the rings. Claims 1 and 11, as amended, affirmatively recite heteroaryl of monocyclic or polycyclic ring(s) having from 1 to 5 hetero atoms, and heterocycle of monocyclic or bicyclic ring(s) having from 1 to 5 hetero atoms. Further, claims 1 and 11 also recite hetero atoms to be N, O, and S. Please see support for this in the specification at page 12, line 17 through page 13, line 13. Thus it is respectfully submitted that claims 1 and 11, as amended, satisfies the requirements of 35 U.S.C. § 112, second paragraph. A similar amendment has also been made to claim 14 to place it in condition for allowance as the Applicants believe that method of use claims should be rejoined with the compound claims as already argued above.

The Examiner further states that the proviso in claims 1 and 11 is unclear as to whether it requires only one of the three listed conditions be met for the compound to be included in the claims. Claims 1 and 11, as amended, contain a proviso, which now requires only one condition, thus eliminating this issue. A similar amendment has been provided for claim 14.

In view of the foregoing arguments it is respectfully submitted that claims 1-2, 5, 11 and 12 fully satisfy the requirements of 35 U.S.C. § 112, second paragraph. Therefore, withdrawal of this rejection as to claims 1-2, 5, 11 and 12 is respectfully requested.

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Rejection Under 35 U.S.C. § 102(b)

Claims 1, 2, 4, 11, 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tully (GB 2185255, PTO-1449).

Specifically, the Examiner asserts that compounds of Tully, for e.g., Examples 1, 4-5, 7-8, 10 and the pharmaceutical composition thereof, are encompassed by the instant claims. In addition, it is alleged that the prior art compounds of Examples 1, 5, 7 are identical to the three compounds of instant claim 4.

It is respectfully submitted that claims 1 and 11, as amended, do not anticipate on Tully because of the fact the amended proviso in claims 1 and 11 now reads affirmatively, when A is C₁-C₆alkyl, B is not a covalent bond. Similarly, the affected three prior art compounds listed in claim 4 have been deleted. In view of this, claims 1, 2, 4, 11 and 12, as amended, fully satisfy the requirements of 35 U.S.C. § 102(b), and therefore, withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 102(e)

Claims 1, 2, 11 and 12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Flohr (U.S. Patent 6,841,556).

The Examiner states that the applied reference has a common assignee with the instant application. The Examiner further states that based upon the earlier effective U.S. filing date of eth reference, it constitutes prior art under 35 U.S.C. § 102(e). However, as noted above, independent claims 1 and 11, as amended, do not anticipate on Flohr. Therefore, it is respectfully submitted that this rejection is rendered moot. In view of the foregoing, withdrawal of this rejection as to claims 1, 2, 11 and 12 under 35 U.S.C. § 102(e) is respectfully requested.

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Double Patenting

Claims 1, 2, 11 and 12 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 10-12 of U.S. Patent No. 6,841,556.

Applicants submit herewith a terminal disclaimer and a statement that the undersigned is authorized to act on behalf of the assignee of record. Thus, rejection as to claims 1, 2, 11 and 12 is respectfully requested.

Allowable Subject Matter

Claims 3 and 13 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As noted above, independent claims 1 and 11 have been amended to place them in condition for allowance. Further, it is respectfully submitted that claims 3 and 13 depend directly upon claims 1 and 11 respectively, and therefore claims 3 and 13 are also in condition for allowance. In addition, as further argued above, claim 4 has also been amended to place it in condition for allowance. Furthermore, claim 14 has been amended to place it in condition for allowance. As further noted above it is respectfully submitted that claims 5-10 and 14-24 should be rejoined pursuant to the provisions of MPEP 821.04, and therefore, claims 1-24 are in condition for allowance and such an action is earnestly requested.

Conclusions

In view of the above Remarks, it is respectfully submitted that claims 1 to 24 are now in condition for allowance and the early issuance of this case is respectfully requested. In the event the Examiner wishes to contact the undersigned regarding any matter, please call (collect if necessary) the telephone number listed below.

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As noted above, Applicants submit concurrently herewith a terminal disclaimer. The Commissioner is hereby authorized to charge any fees due to this submission to Deposit Account No. 18-1982 for Aventis Pharmaceuticals Inc. Bridgewater, NJ. Please credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,

April 8, 2005

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Encl: Terminal Disclaimer

Statement Under 3.73(b)

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